

Application Serial Number 09/749,832
Response to Office Action
Dated March 10, 2005

REMARKS / DISCUSSION OF ISSUES

Claims 1-25 are pending in the application. Claims 1,14,19 and 24 are the independent claims.

Rejections Under 35 U.S.C. § 112

Claim 21 was rejected under 35 U.S.C. § 112 ¶2 as being indefinite. In particular, claim 21 depended from claim '0.' This error has been corrected by the present amendment. As such, it is respectfully submitted that this rejection be withdrawn.

Rejections Under 35 U.S.C. § 102

Claims 1,3,7-13,22 and 24 were rejected under 35 U.S.C. § 102(e) as being anticipated by *Grivna* (U.S. Patent 6,385,745). For at least the reasons set forth below, it is respectfully submitted that this rejection is improper and should be withdrawn.

A proper rejection for anticipation requires, as the first step in the inquiry, that all the elements of the claimed invention be described in a single reference. A necessary corollary to the test of anticipation is that the absence from the reference of any claimed element negates anticipation.

Claim 1 is drawn to an apparatus and features an inverted Digital Video Broadcast-Asynchronous Serial Interface (DVB-ASI) signal. The apparatus also features an inverting adapter that is adapted to invert the inverted DVB-ASI signal.

In an embodiment, the inverting adapter usefully prevents the loss or waste of the inverted DVB-ASI signal and allows the inverted DVB-ASI signal to be reused.

Contrastingly, the reference to *Grivna* discloses a receiver that may operate with both true and complement data streams. The circuit 50 comprises a

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receive equalization circuit 54, a logic circuit 56 and a state machine circuit 58. The receive equalization circuit 54 receives a data signal from the data cable 52. A first signal is provided to inputs of a logic 56. A second signal, which is the complement of the first signal is provided to the logic 56 as well. The logic includes a multiplexer 78 and a PLL decoder framer 80.

The second signal is provided to the inverting input of the differential amplifier 74 and the non-inverting input of the differential amplifier 76. The first signal is provided to the non-inverting input of the differential amplifier 76 and to the non-inverting input of the differential amplifier 74. The differential amplifiers 74, 76 present signals to the multiplexer 78. The multiplexer 78 presents a signal at an output 86 that may be derived from either input 82 or 84 in response to a control signal. Thereafter, the PLL decoder framer 80 provides an output 90 and an error signal at the output 92.

Accordingly, while the reference to *Grivna* does disclose true and complement data streams, the reference does not disclose the featured **inverting adapter to invert the DVB-ASI streams**. Rather, *Grivna* discloses a **logic 56 including differential amplifiers that are input to a multiplexer and a PLL Decoder Framer that provides a data signal and an error signal**. For at least this reason, it is respectfully submitted that the reference to *Grivna* lacks at least a single feature of claim 1. As such, the claim 1 and the claims that depend therefrom are patentable over the applied art. Allowance is earnestly solicited.

The above traversal notwithstanding, it is respectfully submitted that the reference to *Grivna* specifically lacks at least one feature of dependent claim 3. To this end, claim 3 recites that the *"...adapted DVB-ASI signal is coupled to a DVB-ASI device selected from the group consisting essentially of a recorder, a monitor, a decoder, a network..."* The adapted signal is thus readily used by one of a variety of devices. One such device is a monitor, which in the context of the claim and filed application is a viewing monitor. The Office Action relies on a monitoring function of the state machine 58, which is clearly not a monitor as

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featured in claim 3. Accordingly, and for at least this reason, it is respectfully submitted that claim 3 is patentable over the applied art.

Claim 24 is drawn to a method of processing DVB-ASI signals. *Inter alia*, claim 24 features **generating** a DVB-ASI signal and an inverted DVB-ASI signal. The claim also features inverting the inverted DVB-ASI signal to create an adapted DVB-ASI signal.

In rejecting claim 24, the Office Action refers to the rejection of claim 1. Notably, the reference to *Grivna* is drawn to a **receiver** and thus receives rather than generates signals. Therefore, it is respectfully submitted that *Grivna* lacks at least the disclosure of generating a DVB-ASI signal and an inverted DVB-ASI signal.

Accordingly, it is respectfully submitted that independent claim 24 and claim 25, which depends therefrom are patentable over the applied art. Allowance is earnestly solicited.

For at least the reasons set forth above, it is respectfully submitted that the reference to *Grivna* lacks the disclosure of at least one of the features of each of independent claims 1 and 24. Therefore, *Grivna* cannot serve to establish a prima facie case of anticipation of claims 1 and 24. As such, it is respectfully submitted that claims 1 and 24 are patentable over the applied art. Moreover, all claims which depend from claims 1 and 24 are also patentable over the applied art at least because of their dependence on these independent claims.

Rejections Under 35 U.S.C. § 103(a)

1. Claims 2, 4-6, 14-20, 23 and 25 were rejected under 35 U.S.C. § 103(a) over *Grivna* in view of *Takahashi, et al.* (US 2002/0145661A1). For at least the reasons set forth herein, it is respectfully submitted that these claims are patentable over the applied art.

A proper rejection under 35 U.S.C. § 103(a) requires that all of the claimed

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elements be found in the applied art. If a single claimed element is not found in the applied art, a *prima facie* case of obviousness cannot be properly established.

Furthermore, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is reason, suggestion or motivation to do so found in the references themselves or in the knowledge generally available to one of ordinary skill in the art. However, hindsight is never an appropriate motivation for combining references.

First, it is noted that claims 2,4-6 and 25 that depend from claims 1 and 24, respectively, are allowable for at least the reasons set forth above.

Independent claim 14 is drawn to a system and features: "...an *inverting adapter comprising a transformer comprising primary and secondary sides...*"

As stated previously in connection with the response to the rejection under 35 U.S.C. § 102, it is respectfully submitted that the reference to *Grivna* lacks at least the disclosure of the inverting adapter.

The Office Action references column 4, lines 14-18 of *Grivna* for the disclosure of a transformer. The referenced portion to *Grivna* discloses an equalizer circuit 54 that may not be present in DVB-ASI specifications. *Grivna* notes that if the receive equalizer circuit is not present, the coax data cable may be transformer coupled to the inputs of the receiver circuit 56. In the previous rejection, the Office Action attempted to rely on the features of the circuit 56 for the disclosure of an inverting adapter. Applicant respectfully traversed this assertion, and reiterates this traversal with respect to claim 14.

In the present rejection, the Office Action is attempting to rely on the disclosure of transformer coupling a coax line 32 to the **input** of the circuit 56. Such reasoning is flawed. To wit, the featured inverting adapter of claim 14 **includes** the transformer, whereas the transformer of *Grivna* is not even an element of the circuit 56. Therefore, assuming *arguendo* that the circuit 56 of

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Grivna is an inverting adapter, the circuit 56 cannot comprise the transformer because the transformer is necessarily not included in the circuit 56, but rather connects the coax line 32 to the circuit 56. Therefore, not only does the reference to *Grivna* lack the disclosure of the inverting adapter featured in claim 14, it also lacks the disclosure of the inverting adapter comprising the transformer.

Claim 19 is drawn to an inverting adapter for inverting DVB-ASI signals. The inverting adapted features "...an inverting adapter comprising a transformer comprising primary and secondary sides.." The Office Action relies on the same teaching of *Grivna* discussed in connection with the rejection of claim 14. Accordingly, the rejection of claim 19 is improper at least for the same reason that the rejection of claim 14 is improper.

In addition, Applicant respectfully traverses the propriety of the combination of references. As noted, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is reason, suggestion or motivation to do so found in the references themselves or in the knowledge generally available to one of ordinary skill in the art. The Office Action notes that the reference to *Grivna* fails to disclose the primary and secondary windings as recited in claims 2 and 14. The Office Action relies on *Takahashi, et al.*, stating that it would have been obvious at the time the invention was made "...to modify *Grivna* with primary and secondary windings, as in *Takahashi*, so that the correct signal was applied to the circuit. The Office Action also states that "it is expected in the art for transformers to have primary and secondary windings." (Kindly refer to pages 5 and 7 of the Office Action.)

Initially, it is noted that the Office Action fails to provide from the references themselves the reason, suggestion or motivation to combine the teachings of the applied art. Moreover, no evidence is provided that the motivation to combine references is found in the knowledge generally available to

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one of ordinary skill in the art. If the noted need to provide the correct signal to the circuit is the motivation to combine the references, Applicant respectfully requests that the Examiner point to the germane portion of the applied references or provide extrinsic evidence that this is knowledge generally available to one of ordinary skill in the art.

Furthermore, it is submitted that the transformer coupling described in *Grivna* is not necessarily a transformer with windings as asserted, but rather may be a solid-state transformer. As such, it is submitted that application of *Takahashi, et al.* is impermissible hindsight.

Finally, the Examiner takes official notice "...that it is well known and expected in the art to use a variety of winding ratios, including an equivalent number, in order to produce a desired signal." (Kindly refer to page 7 of the Office Action.) If the position of official notice set forth in the Office Action is based on personal knowledge of the Examiner, an affidavit under 37 CFR § 1.104(d)(2) is respectfully requested. Otherwise, some other form of extrinsic evidence in support of this assertion is respectfully requested. If evidence in support of the official notice taken in the Office Action are not provided it is respectfully submitted that the rejections based thereon be withdrawn.

For at least the reasons set forth above, it is respectfully submitted that independent claims 14 and 19 are patentable over the applied art. Moreover, it is respectfully submitted that the claims that depend from claims 14 and 19 are patentable over the applied art at least because of their dependence thereon.

2. Claim 21 was rejected under U.S.C. § 103(a) over *Grivna* in view of *Takahashi, et al.* and *Wilkins, et al.* (U.S. 2002/0145661).

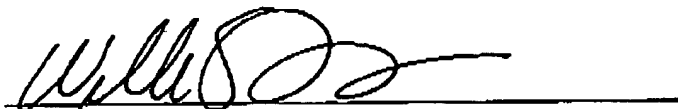
Claim 21 depends from claim 19, which for at least the reasons set forth above is patentable over the applied art. Accordingly, and while in no way conceding to the propriety of the rejection of claim 21, it is respectfully submitted that claim 21 is patentable at least because of its dependence on claim 19.

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Conclusion

In view of the foregoing, applicant(s) respectfully request(s) that the Examiner withdraw the objection(s) and/or rejection(s) of record, allow all the pending claims, and find the application in condition for allowance. If any points remain in issue that may best be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted on behalf of:
Phillips Electronics North America Corp.



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